

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 14287US02)**

In the Application of:

Jeyhan Karaoguz, et al.

Electronically filed on 04-APR-2008

Serial No. 10/675,122

Filed: September 30, 2003

For: PORTABLE MEDIA PROCESSING
UNIT IN A MEDIA EXCHANGE
NETWORK

Examiner: Diane D. Mizrahi

Group Art Unit: 2165

Confirmation No. 4964

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on October 4, 2007 (hereinafter, the Final Office Action) with a period of reply through April 4, 2008. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

The Applicant points out that a response to the October 4, 2007 Final Office Action was timely filed on November 28, 2007. Even though the Applicant filed the November 28, 2007 response within two months of the Final Office Action, the Examiner has not responded with an Advisory Office Action, as required by

MPEP § 706.07(f). Furthermore, if the Examiner is still of the opinion that the response to the Final Office Action does not place the application in condition for allowance, the Examiner should have informed the Applicant (in the Advisory Office Action) that the shortened statutory period (SSP) for reply expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, *whichever is later*. See MPEP § 706.07(f)(C)(3). Since the Examiner has not sent an Advisory Office Action even after the third month from the date of the Final Office Action, the SSP may not be determined correctly. Consequently, due to the Examiner's delay and not sending an Advisory Office Action, the Applicant submits that no extension fees are due at this time.

REMARKS

The present application includes pending claims 1-32. Claims 1-10 and 21-32 have been allowed. Claim 11 has been rejected. Claims 12-20 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. The Applicant respectfully submits that the claims define patentable subject matter.

Claim 11 is rejected under 35 U.S.C. § 101 because the claim is allegedly directed to a non-statutory subject matter. The Applicant respectfully traverses this rejection at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. REJECTION UNDER 35 U.S.C. § 101

The Applicant turns to the rejection of claim 11 under 35 U.S.C. § 101. The Final Office Action states the following:

Claim 11 is rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. As noted below, claim 11 is directed to neither a "process" nor an "apparatus," but rather embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set requirements for the statutory classes of invention in the alternative only. See, *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

See the Final Office Action at page 3. The Applicant respectfully disagrees. The Examiner is referred to the following citation from the Manual of Patent Examining Procedure, 8th Edition, Revision 5, August 2006 (MPEP):

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, **“functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component.** (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) **“Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.**

See the MPEP, Chapter 2106.01. The Applicant points out that the descriptive material in the preamble of claim 11 is not related to “music, literary works, and a compilation or mere arrangement of data.” Instead, the Applicant points out that the descriptive material in the preamble of claim 11 is related to “computer programs which impart functionality when employed as a computer component.” In other words, **the material in the preamble of claim 11 is “functional descriptive material,”** as per the above MPEP citation. The Examiner is also referred to the following MPEP citation for support:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

See id. The Applicant points out that claims 11-20 recite a “computer-readable medium”, which is the phraseology used in the above MPEP analysis. The Applicant, therefore, submits that the material in the preamble of claim 11 is functional descriptive material, which is also statutory, as per the above MPEP guidelines. The Applicant submits that claims 11-20 are, therefore, directed to statutory subject matter, and that the rejection of claim 11 under 35 U.S.C. § 101 should be withdrawn.

II. Conclusion

The Applicant respectfully submits that all claims 1-32 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. **The Commissioner is authorized to charge any necessary fees, including any extension fee deemed necessary by the PTO to make this filing timely, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.**

Respectfully submitted,

Date: 04-APR-2008

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